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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 09/591,009 | 06/09/2000 | Ashok K. Shukla | | 3502 |

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EXAMINER

THERKORN, ERNEST G

| ART UNIT | PAPER NUMBER |
|----------|--------------|
| 1723 | 8 |

DATE MAILED: 01/04/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

| | |
|-------------------------|-----------------|
| Application No. | Applicant(s) |
| 09/591,009 | Shukla |
| Examiner THERESA ORN | Art Unit 123 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on December 6, 2001.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-20 is/are pending in the application.

4a) Of the above, claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-20 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claims _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are objected to by the Examiner.

11) The proposed drawing correction filed on _____ is: a) approved b) disapproved.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) All b) Some* c) None of:

- Certified copies of the priority documents have been received.
- Certified copies of the priority documents have been received in Application No. _____.
- Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) Notice of References Cited (PTO-892) 18) Interview Summary (PTO-413) Paper No(s). _____

16) Notice of Draftsperson's Patent Drawing Review (PTO-948) 19) Notice of Informal Patent Application (PTO-152)

17) Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____ 20) Other: _____

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Claims 3, 4, 6, 7, 11, 12, 13-15, and 18-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 3's "of any shape or size" renders the claim indefinite. Claim 4's "in any configuration including but not limited to" renders the claim indefinite. Claim 6's "does not contain a chromatography or separation material" impermissibly contradicts the independent claim. Claim 7's "consisting of but not limited to" renders the claim indefinite. Claim 11's "or using any other methods that can be used to perforate, cut or crack the said pipette tip" renders the claim indefinite. Claim 12's "the molding process" lacks antecedent basis. Claim 13's "or in any other physical configuration conditions" renders the claim indefinite. Claim 14's "such as" renders the claim indefinite. Claim 15's "or any other media" renders the claim indefinite. Claim 18's "any method used to separate, filter or purify molecules or particles" and "or any other applicable methods" renders the claim indefinite. Claim 19's "other bio-molecules" renders the claim indefinite. Claim 20's "or similar device" is considered to render the claim indefinite.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

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The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-20 are rejected under 35 U.S.C. 102(E) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Valaskovic (U.S. Patent No. 6,190,559). The claims are considered to read on Valaskovic (U.S. Patent No. 6,190,559). However, if a difference exists between the claims and Valaskovic (U.S. Patent No. 6,190,559), it would reside in optimizing the elements of Valaskovic (U.S. Patent No. 6,190,559). It would have been obvious to optimize the elements of Valaskovic (U.S. Patent No. 6,190,559) to enhance separation.

Claim 4 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valaskovic (U.S. Patent No. 6,190,559) in view of Sanford (U.S. Patent No. 5,589,063). At best, the claim differs from Valaskovic (U.S. Patent No. 6,190,559) in reciting use of multiple units. Sanford (U.S. Patent No. 5,589,063) (column 2, lines 11-18) discloses that use of an array of columns allows automated processing without technician intervention. It would have been obvious to use an array of columns in Valaskovic (U.S. Patent No. 6,190,559) because Sanford (U.S. Patent No. 5,589,063) (column 2, lines 11-18) discloses that use of an array of columns allows automated processing without technician intervention.

Claim 20 is rejected under 35 U.S.C. 103(a) as being unpatentable over Valaskovic (U.S. Patent No. 6,190,559) in view of Golias (U.S. Patent No. 4,341,635). At best, the claim differs

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from Valaskovic (U.S. Patent No. 6,190,559) in reciting use of a piston. Golias (U.S. Patent No. 4,341,635) (column 3, lines 20-26) discloses that use of a plunger forms a pressure drop across the particles. It would have been obvious to use a plunger in Valaskovic (U.S. Patent No. 6,190,559) because Golias (U.S. Patent No. 4,341,635) (column 3, lines 20-26) discloses that use of a plunger forms a pressure drop across the particles.

The restriction requirement has been reconsidered, deemed proper, and made final for the reasons of record.

Any inquiry concerning this communication should be directed to E. Therkorn at telephone number (703) 308-0362.



Ernest G. Therkorn
Primary Examiner
Art Unit 1723

EGT/12
January 3, 2002